



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,533	08/31/2001	Howard M. Marks	KONAMI01-07	8528

52396 7590 10/03/2005

MORISHITA LAW FIRM, LLC
3800 HOWARD HUGHES PARKWAY
SUITE 850
LAS VEGAS, NV 89109

EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,533

Applicant(s)

MARKS ET AL.

Examiner

Robert Mosser

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 11, 15 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 11, 15 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION



Responsive to the amendment filed 4/29/04 and the Petition granted 5/7/2004.

Claims 2-4, 11, 15, and 22-25 are pending.

This action is Final.



Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **2-4, 11, 15, and 22-25** are rejected under 35 U.S.C. 102(b) as being anticipated by Marnell (US 5,393,057).

Claims 2-4: Marnell teaches a processor for identifying, displaying, and activating coordinates responsive to the selection of game symbols assigned to the activated coordinate as set forth in the rejection of at least claims **22** and **24** below.

Claims 11: Marnell teaches the inclusion of scatter combinations including "four corners" (Col 9:33-41)

Claims 15: Marnell teaches the inclusion a bet acceptor for accepting bet from the player (Col 4:18 & 4:57-59).

Claims 22, 24: Marnell teaches an electronic gaming apparatus and method including:

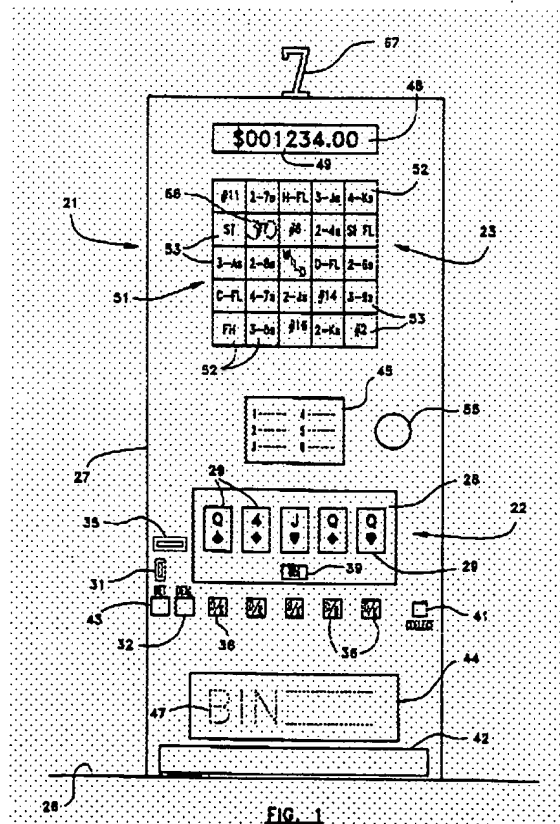
a display (Figures 1-2);

a data structure storing data corresponding to game symbols and winning symbol combinations, at least one of said game symbols defining a trigger symbol (Figure 4);

a processor (Figure 4) for driving game related features including display updating, user input management, the selection and assignment of game and trigger symbol data to an XY coordinate matrix (Element 51) wherein said matrix further includes at least one payline (Col 9:28-41);

the continued display of at least one activated coordinate in the XY matrix through successive rounds of play (Col 5:39-6:27);

the processor further configured to monitor the progress of a base game and award a player for any winning combination of game symbols in a base game without consideration given to any activated coordinates in the XY matrix (Col 6:14-17); and



Art Unit: 3714

the processor further configured to monitor the progress of the XY matrix and award a player for any winning combination of game symbols present in the matrix from a plurality of possible prize selections (Col 6:18-27 & Col 10:11-17).

Claims 23, 25: Marnell teaches the awarding of different prizes resultant of a winning hand/combination in a base game (Col 4:46-50) concurrent with the awarding of a matrix location (Col 5:51-6:8) and hence meets the claimed presentation of a triggered award based upon the selection and activation of a matrix coordinate.

Response to Arguments

Applicant's arguments with respect to claims **2-4, 11, 15, and 22-25** have been considered but are moot in view of the new ground(s) of rejection.

For the purposes of furthering prosecution and clarity the following issues raised in the reply by applicant have been addressed with reflection to the newly applied art.

Applicant's arguments dated April 26th, 2004 include on the second page third full paragraph, the address of a "player selected" reward. These arguments address features not presently incorporated into the claims while, the equivalent ^{language} ~~language~~ present does not support such a narrow interpretation of the claim limitation.

Remaining issues are believed addressed in the rejection above.

Conclusion

Art Unit: 3714

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lewis (6,656,044) teaches a Bingo/Poker game.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

Chanda L. Harris
CHANDA L. HARRIS
PRIMARY EXAMINER